



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,545	08/21/2003	Douglas S. Hine	P0011138.00/LG10126	9714
27581	7590	10/27/2010		
MEDTRONIC, INC. 710 MEDTRONIC PARKWAY NE MINNEAPOLIS, MN 55432-9924			EXAMINER ALTER, ALYSSA MARGO	
			ART UNIT	PAPER NUMBER
			3762	
			NOTIFICATION DATE	DELIVERY MODE
			10/27/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

rs.docketingus@medtronic.com
sso@cardinal-ip.com

Office Action Summary	Application No. 10/646,545	Applicant(s) HINE ET AL.	
	Examiner Alyssa M. Alter	Art Unit 3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 11-13 and 16-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 11-13 and 16-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 1-6, 11-13, and 16-22 have been considered but are moot in view of the new ground(s) of rejection necessitated by amendment.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-6, 11-13, and 16-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Osypka (US Patent Publication 20030077943 A1). Osypka discloses an adapter for electrical connection to an implantable medical device having a connector bore as depicted in figures 3-5. As depicted in figures 3 (with separate single leads) and 5 (with a combined single lead), a single lead connector includes a plurality of lead connector elements having a plurality of elongated insulated conductors and lead electrodes.

As to the set of adapters, the examiner considers the adapter as disclosed by Osypka and depicted in figure 3-6 to be a set of adapters, with 511a or 611a being the first adapter and 511b or 611b being the second adapter. Additionally, the first and

second adapters are used separately since each one engages with a different receptacle (depicted in figure 5 as 521a-c).

Furthermore, Osypka discloses an adaptor for use with both a unipolar lead connector and a bipolar lead connector as depicted in figures 5 and 6. Referring to figure 5, the “trifurcated lead adapter 500 is configured such that receptacle 511a accepts a unipolar DF-1 type connector, receptacle 521b accepts a bipolar IS-1 type connector, and receptacle 511c accepts a unipolar DF-1 type connector. Those skilled in the art will readily appreciate that other combinations of connectors and receptacles can be arranged, and that receptacles 521a, 521b and 521c of adapter 500 can be configured to accept unipolar or bipolar connectors” (page 4, paragraph 45).

Therefore, since the inner surface engaging either a unipolar or bipolar connectors, the “internal surface forming a lumen to receive the single lead connector” of the unipolar first adapter has “the contact elements of the first adapter is located in a different location along the internal surface” than the second bipolar adapter.

In addition, since the first adapter and second adapter both share the connector 514 or 614, both adapters have the same “external surface to engage the inner surface of the connector bore” are “located in the same location along the external surface”.

As to claims 2, Osypka discloses the employment of industry standard leads and adapters, ex. IS-1 type lead connector (see page 1, paragraph 9).

As to claim 3, although Osypka does not explicitly disclose a connector ring distal to the lead connector elements, Osypka does depict a connector ring in figure 5.

Additionally a bipolar IS-1 type lead necessarily has a connector ring.

As to claim 4, additionally depicted in figure 5, is the lead connectors further include a plurality of sealing rings position distal to the connector elements. In figure 5, there are two sets of sealing rings with one set distal to the connector ring and another set proximal to the connector ring.

As to claim 5, the examiner considers the sealing rings depicted in the figures to be an "outwardly extending protrusion".

As to claim 6, the examiner considers the lumen of the adapter to be press fit or friction fit since the lead with the sealing rings engages sufficiently with the lumen to prevent permeation of body fluids.

As to claim 12, since the first and the second adapters both have the same conductive portions on the external connector bore engagement surface, the selected adapter (either the first or second adapter) is positioned within the connector bore.

As to claim 20, Osypka discloses the external contact element of the first and second adapters comprises a ring contact 13a or 213a, depicted in figures 1 and 2, respectively.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

Art Unit: 3762

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 21-22 is rejected under 35 U.S.C. 103(a) as being obvious over Osypka (US Patent Publication 20030077943 A1). Osypka discloses the invention substantially as claimed but is silent as to the diameter opening of the first adapter being larger than the opening of the second adapter. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the diameter opening of the adapters to provide the predictable result of ensuring compatibility with multiple types of leads. Additionally, it has been held that where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. *In Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984.) See the MPEP 2144.04

As to claim 22, Osypka discloses the invention substantially as claimed except for a label on the surface of the first and second adapters. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include labels on the external surfaces of the adapters in order to provide the predictable results of quick and easy identification of the kit components.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alyssa M. Alter whose telephone number is (571)272-4939. The examiner can normally be reached on M-F 8am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Niketa Patel can be reached on (571) 272-4156. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Niketa I. Patel/
Supervisory Patent Examiner, Art Unit 3762

/Alyssa M Alter/
Examiner
Art Unit 3762